

REMARKS/ARGUMENTS

Claim 27 is amended, and claims 45 and 46 are newly added. Claims 1-3, 5-10, 12-16, and 27-46 (of which claims 6-9, 13-16, 32-34, and 42-44 are withdrawn) are now pending in the application. Applicants respectfully request reconsideration and reexamination of the application as amended.

Initially, Applicants acknowledge with appreciation the Examiner's indication that claims 1-3, 5, 10, and 12 are allowable and claims 28-31 and 41 contain allowable subject matter. As discussed below, Applicants assert that all pending claims (including the withdrawn claims) are in condition for allowance.

Claims 35-39 were objected to because of questions regarding the "means for reducing a temperature gradient." Applicants respectfully traverse this objection.

35 USC § 112, sixth paragraph, expressly allows a claim element to be expressed in terms of a means for performing a function, while requiring that the specification disclose at least one exemplary device or structure for performing the function. (See 35 USC § 112, sixth paragraph.) Here, the specification identifies temperature control elements 470 and 475 as one non-limiting example of devices for performing the function of compensating "for any thermal gradient." (See specification, pg. 11, lines 16-18.) The "means for reducing a temperature gradient" element of claim 35 thus fully complies with all applicable statutes and rules and is not objectionable. Applicants therefore request that the objection to claims 35-39 be withdrawn.

Claims 27, 35, 36, and 40 were rejected under 35 USC § 102(b) as anticipated by US Patent No. 5,124,639 to Carlin et al. ("Carlin"). Applicants respectfully traverse this rejection.

Carlin's stiffener (which appears to be nothing more than the prior art stiffener 365 shown in Figure 3 of the instant application) is not "an energy transmissive element disposed to transmit energy to said probe card to counteract thermally induced bowing of said probe card," as required by independent claim 27. Similarly, Carlin's stiffener does not "reduc[e] a temperature gradient between said device side of said probe card and said second side of said probe card." Carlin therefore also fails to meet the requirements of independent claim 35.

For these reasons alone, the rejection of independent claims 27 and 35 should be withdrawn.

Moreover, Carlin's stiffener, on one hand, and the energy transmissive element of claim 27 and the means for reducing a temperature gradient of claim 35, on the other hand, are not equivalents merely because each can perform the same high level function of counteracting

thermally induced bowing of a probe card. Indeed, a bicycle and a jet airplane perform the same high level function of moving a person from one place to another but are not equivalents because they do so in different ways. Here, the energy transmissive element of claim 27 counteracts thermally induced bowing of a probe card by "transmit[ing] energy to said probe card," and the means for reducing element of claim 35 "reduce[s] a temperature gradient between said device side of said probe card and said second side of said probe card." Carlin's stiffener, on the other hand, merely attempts to stiffen the probe card. Therefore, Carlin's stiffener is not equivalent to the energy transmissive element of claim 27 or the means for reducing element of claim 35.

It should also be mentioned that it is insufficient for a prior art reference merely to disclose the equivalent of a claim element. Indeed, to support a rejection of anticipation under 35 USC § 102, the prior art reference must disclose the claim element exactly as described in the claim. (See MPEP § 2131.)

For all of the foregoing reasons, Carlin does not anticipate independent claims 27 or 35. Therefore, independent claims 27 and 35, as well as the claims that depend therefrom (including claims 36 and 40), patentably distinguish over Carlin.

As discussed in the Amendment filed on September 8, 2004, claim 1 is a linking claim that links the invention of claim 1 to the inventions of withdrawn claims 6-9 and 13-16. As claim 1 is now allowable, claims 6-9 and 13-16 must be rejoined and examined. (See MPEP § 809.) Applicants respectfully request that the Examiner do so. Moreover, claims 6-9 and 13-16 should be allowable because of their dependency on claim 1.

As also discussed in the Amendment filed on September 8, 2004, claim 27 is a linking claim that links the invention of claim 27 to the inventions of withdrawn claims 32-34, and claim 35 is a linking claim that links the invention of claim 35 to the inventions of withdrawn claims 42-44. Applicants therefore request that, upon allowance of independent claims 27 and 35, withdrawn claims 32-34 and 42-44 be rejoined and examined.

In view of the foregoing, Applicants submit that the all pending claims are allowable, including withdrawn claims 6-9, 13-16, 32-34, and 42-44, which should now be rejoined. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

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